



Attorney's Docket No. HOS-62
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Group Art Unit: 1771
MORITA; MUROI; KAKUTA)
Serial No.: 09/996,777) Examiner: V. HAI
Filed: November 30, 2001)
For: **MULTIPLE LAYERSLAMINATED POLYOLEFIN FOAM**

TRANSMITTAL LETTER

Commissioner for Patents
Washington, D.C. 20231

Sir:


Submitted herewith for filing in the U.S. Patent and Trademark Office is the following:

- (1) Filing Receipt;
- (2) Transmittal Letter; and
- (3) Response to Restriction/Election Requirement.

Please charge any additional fees, or credit any overpayment, in connection with this matter to deposit Account No. 19-1980.

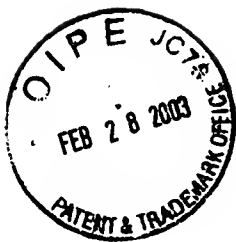
Respectfully submitted,

SHERMAN AND SHALLOWAY


Attorney for Applicants
Roger C. Hahn
Reg. No. 46,376

SHERMAN AND SHALLOWAY
413 N. Washington Street
Alexandria, Virginia 22314
703-549-2282

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RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Official Action bearing a mail date of February 4, 2003. A one-month shortened statutory period for response is set to expire on March 4, 2003. Accordingly, this response is timely filed.

SUMMARY OF RESTRICTION/ELECTION REQUIREMENT

The restriction/election requirement states as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention: a polymer-type antistatic agent to be elected either (a) polyetheresteramides or (b) polyether.

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ELECTION

Applicants elect the polyether species of the claimed invention.

In the event the Restriction is not overcome, Applicants specifically preserve the right to pursue the subject matter of the un-elected claims in later applications and for purposes of preserving the record for appeal.

TRAVERSAL

Applicants respectfully traverse the Examiner's Restriction Requirement because presently pending claims 1-3, 15-16 and 21-26 do not recite mutually exclusive limitations that separate the alleged species of polyetheresteramides and polyethers from each other.

Binding precedent states that the touchstone for requiring restriction is determining whether two or more independent and distinct inventions are claimed within the same application. MPEP §806. Restriction should never be required where the claims of an application define the same essential characteristics of a single disclosed embodiment of the invention. MPEP §806.03.

Furthermore, claims alleged to be drawn to different species must contain mutually exclusive limitations defining those allegedly different species. MPEP §806.04(f). For example, a

proper restriction can be made between a first claim reciting limitations which under the disclosure are found in a first species but not in a second, and a second claim reciting limitations disclosed only for the second species and not the first. Id. In other words, claims to be restricted to different species must contain within the language of the claim the mutually exclusive limitations for those species.

In the present application, claims 1-3, 15-16 and 21-26 do not recite mutually exclusive limitations that separate the alleged species of polyetheresteramides and polyethers from each other. In particular, the single independent claim 1 recites a multiple layers laminated polyolefin foam having

a plurality of polyolefin layers laminated on at least one side of a polyolefin foam by a coextrusion method,

wherein the thickness of the outermost layer constituting said plurality of polyolefin layers is 5 to 80 μm

including various limitations as to the melt flow rate, density, thickness and specific mathematical relationships between the melt flow rate, density and thickness.

Nowhere within claim 1 are there any limitations directed to mutually specific limitations between polyetheresteramides and polyethers. The specific recitation of a "polymer-type antistatic

agent" does not even appear within claim 1 and is only recited later in dependent claim 15.

Furthermore, a clear relationship between the species is disclosed. The specification clearly states that the term "polymer-type" antistatic agent means a resin with a number average molecular weight of at least no less than 300, preferably 300 to 300,000, even more preferably, 600 to 15,000, and with a surface resistivity of less than $1 \times 10^{12} \Omega$ wherein the agent may contain inorganic salts or organic protonic salts with a low molecular weight. See Specification at page 22, lines 10-22. The specification further provides specific examples of the agent as resins such as polyethylene oxide, polypropylene oxide, polyethylene glycol, polyethers, **polyesteraminde** and **polyetheresteramides**. See Specification at page 23, lines 4-8. Based on the supporting disclosure, it is clear that there is no mutually exclusive limitation for polyetheresteramides and polyethers within any of the claims. See MPEP §808.01(a).

Turning to the Office Action's assertion that Applicants are required to state that the species are unpatentable (obvious) over the other, Applicants note that the need for such a statement is obviated by the disclosure showing a relationship between polyetheresteramides and polyethers. Applicants note that they are in no way asserting or making any characterization regarding the

patentability or the nature of the invention by these statements.

For all these reasons, Applicants respectfully request that the Restriction be withdrawn.


CONCLUSION

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

SHERMAN AND SHALLOWAY

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413 N. Washington Street
Alexandria, Virginia 22314
703-549-2282



Attorney for Applicants
Roger C. Hahn
Reg. No. 46,376